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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,983	10/30/2003	John R. Woods	81168-306630	7854

7590 06/22/2006

Intellectual Property Group of
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EXAMINER

KUGEL, TIMOTHY J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 06/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/696,983

Applicant(s)

WOODS, JOHN R.

Examiner

Timothy J. Kugel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2006 and 15 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-36 and 55-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28,29,32-36 and 55-67 is/are rejected.
- 7) ☒ Claim(s) 30 and 31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 28-36 and 55-67 are pending as amended on 15 May 2006.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Specification

3. Applicant is thanked for updating the reference to Application No. 09/746,447 to now refer to US Patent 6,641,864 as that application has issued.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 28-36 and 55-66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 28, 55, 57 and 66 the inclusion of a term within parentheses renders the claim indefinite because it is unclear whether the included term is part of the claimed invention.

Regarding claims 28, 55, 56, the limitation "a more controllable aerosol spray" is indefinite because it is unclear to what the invention is being compared.

Regarding claims 57 and 66, the limitation "VOC propellant" is indefinite because it is unclear to what the acronym VOC refers. For the purpose of examination, the acronym VOC was construed to refer to volatile organic compound.

Regarding claims 59 and 60, the inclusion of a trademark—WICHANOL—renders the claim indefinite because the relationship between a trademark and the product it identifies is sometimes indefinite, uncertain, and arbitrary. The formula or characteristics of the product may change from time to time and yet it may continue to be sold under the same trademark. In patent specifications, every element or ingredient of the product should be set forth in positive, exact, intelligible language, so that there will be no uncertainty as to what is meant. Arbitrary trademarks that are liable to mean different things at the pleasure of manufacturers do not constitute such language. *Ex Parte Kattwinkle*, 12 USPQ 11 (Bd. App. 1931).

Claim Rejections - 35 USC § 103

6. Claims 28, 32, 33, 35, 36, 55 and 56 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent 5,505,344 (Woods '344 hereinafter) in view of US Patent 4,472,201 (Ochi hereinafter) and US Patent 5,914,196 (Calvo hereinafter).

Woods '344 teaches an acoustic ceiling patch or textured material in the form of a sprayable composition (Abstract) comprising 25 to 50% of a base comprising water and/or a solvent, 50 to 80% of a filler—including mixtures of limestone (calcium carbonate) and silica—1 to 4% of a binder—including polyvinyl alcohol—5 to 20% of an aggregate, 5-25% of a propellant—including dimethyl ether—0.10% of a defoaming

agent and 0.20% of an antifreeze (Column 2 Lines 16-26 Column 4 Lines 10-39 and Column 4 Line 65 – Column 5 Line 35).

Woods '344 does not disclose expressly foamed polyethylene as the aggregate.

Ochi teaches the use of foamed polyethylene as an aggregate for a hydraulic heat-resisting material (Column 3 Lines 45-53).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the foamed polyethylene as the aggregate in the composition of Woods '344. The motivation to do so would have been to include a shrinkage-resisting agent and to make the composition a lighter weight (Ochi Column 3 Lines 45-53).

Woods '344 does not disclose expressly the use of a suspending agent or a fungicide.

Calvo discloses a water-based surface coating comprising fillers, a 0.1 to 6% of a suspending agent and a 0.1 to 10% of a microbicide (fungicide) (Column 1 Line 65 – Column 2 Line 3 and Column 4 Lines 45-63).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the suspending agent of Calvo in the composition of Woods '344. The motivation to do so would have been to keep the fillers in suspension (Calvo Column 2 Lines 38-41).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the microbicide of Calvo in the composition of Woods '344. The motivation to do so would have been to inhibit the growth of microbes such as bacteria and fungi (Calvo Column 2 Lines 51-55).

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7. Claim 29 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Woods '344 in view of Ochi and Calvo in further view of US 4,450,253 (Suk hereinafter).

Woods '344, Ochi and Calvo teach an acoustic ceiling patch or textured material in the form of a sprayable composition comprising 25 to 50% of a base comprising water and/or a solvent, 50 to 80% of a filler—including mixtures of limestone (calcium carbonate) and silica—1 to 4% of a binder—including polyvinyl alcohol—5 to 20% of an foamed polyethylene aggregate, 5-25% of a propellant—including dimethyl ether—0.10% of a defoaming agent and 0.20% of an antifreeze a suspending agent and a fungicide as described above.

Woods '344, Ochi and Calvo do not disclose expressly the use of the defoaming agent at 1 to 20% of the composition.

Suk discloses an aerosol paint composition comprising up to about 2% of an antifoam agent (Column 7 Lines 40-49).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the level of antifoam of Suk in the composition of Woods '344, Ochi and Calvo. The motivation to do so would have been to permit the ready release of dissolved gasses upon spraying (Suk Column 7 Lines 40-49).

8. Claim 29 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Woods '344 in view of Ochi and Calvo in further view of US 5,500,456 (Hughett hereinafter).

Woods '344, Ochi and Calvo teach an acoustic ceiling patch or textured material in the form of a sprayable composition comprising 25 to 50% of a base comprising

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water and/or a solvent, 50 to 80% of a filler—including mixtures of limestone (calcium carbonate) and silica—1 to 4% of a binder—including polyvinyl alcohol—5 to 20% of an foamed polyethylene aggregate, 5-25% of a propellant—including dimethyl ether—0.10% of a defoaming agent and 0.20% of an antifreeze a suspending agent and a fungicide as described above.

Woods '344, Ochi and Calvo do not disclose expressly the use of the antifreeze at 1 to 10% of the composition.

Hughett discloses an aerosol tire sealer comprising 2 to 8% of an alkylene glycol or propylene glycol antifreeze (Column 5 Lines 45-64)

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the level of antifreeze of Hughett in the composition of Woods '344, Ochi and Calvo. The motivation to do so would have been to allow the spray to be useful below 25 degrees F (Hughett Column 3 Lines 50-55).

9. Claim 34 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Woods '344 in view of Ochi and Calvo as applied to claims 28, 29, 32, 33, 35, 36, 55, and 56 described above in further view of US Patent 4,005,038 (Minkoff hereinafter).

Woods '344, Ochi and Calvo combine to teach an acoustic ceiling patch or textured material in the form of a sprayable composition comprising a base comprising water and/or a solvent, of a filler, a binder, a polyethylene aggregate, a propellant, a defoaming agent, an antifreeze and a suspending agent described above.

Woods '344, Ochi and Calvo do not disclose expressly the use of ethylene glycol as an antifreeze.

Minkoff discloses a paint composition including ethylene glycol (Column 3 Lines 5-10).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use ethylene glycol as an antifreeze in the composition of the combined teachings of Woods '344, Ochi and Calvo. The motivation to do so would have been to protect the composition from low temperatures during storage and shipment.

Response to Arguments

10. Applicant's arguments filed 15 May 2006 have been fully considered but they are not persuasive.

Applicant argues that none of the references applied teaches or suggests an aggregate used in a sprayable composition that is able to maintain its integrity in the presence of VOC propellants; however Ochi teaches the same aggregate as claimed which intrinsically would have the same properties as claimed.

Regarding the two declarations filed pursuant to 37 CFR 1.132 on 7 April 2006:

Both the inventor and Mr. Harry C. Wu profess unexpected results when polyethylene or the claimed rubber particles are substituted for the polystyrene taught by the Woods '344 reference; however, the insolubility of polyethylene or the claimed rubber particles in solvents for polystyrene would not be unexpected to one of ordinary skill in the art.

Allowable Subject Matter

11. Claim 67 is allowed.

12. Claims 57 and 66 would be allowable if rewritten or amended to overcome the rejections under 35 USC 112, 2nd paragraph, set forth in this Office action.

13. Claims 30, 31 and 58-65 would be allowable if rewritten to overcome the rejections under 35 USC 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: None of the prior art referenced above teach or fairly suggest the use of a suspending agent consisting essentially of carbonal.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Kugel whose telephone number is (571) 272-1460. The examiner can normally be reached 6:00 AM – 4:30 PM Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

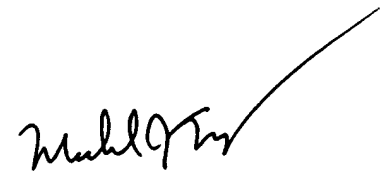
15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TJK

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A handwritten signature in black ink, appearing to read "Michael Feely", with a long, sweeping horizontal line extending to the right.

**MICHAEL FEELY
PRIMARY EXAMINER**